

a third step of carrying out a quality test of each of a plurality of said semiconductor chips, which is formed on said semiconductor wafer, by using said terminal formed by said second step; and

a fourth step of dividing one or a plurality of said semiconductor chips on the basis of a result of said quality test,

wherein said plurality of semiconductor chips are divided into first groups made of four pieces if four pieces are determined to be possible to form a group as a result of said step of carrying out a quality test, but wherein said chips are divided into second groups made of two pieces if four pieces are determined to be not possible to form a group as a result of said step of carrying out a quality test but if two pieces are determined to be possible, and wherein said chips are divided into third groups made of one piece if neither four pieces nor two pieces are determined to be possible to form a group as a result of said step of carrying out a quality test but if one piece is determined to be possible, after said quality test is carried out.

REMARKS

Reconsideration is respectfully requested.

Claims 1-10 are pending in this application. Claims 1-4 are non-elected, and are therefore canceled herein. Claims 7 and 10 are canceled, claims 5 and 8 are amended.

Claims 1-4 are non-elected, and the Examiner has made the restriction requirement final. Therefore, to further the prosecution of the application, non-elected claims 1-4 have been canceled herein.

The Examiner notes that the certified copies of the foreign priority documents had not been filed. Applicant transmits the certified copies in a companion paper herewith.

The Examiner indicates that he did not review the non-English language documents cited in the information disclosure statement. Applicant respectfully submits that the non-English language documents cited in the information disclosure statement were properly cited in accordance with the procedure allowed in the MPEP. Under U.S. practice, the International Search report with the X, or Y indication of relevance of the documents is sufficient for explanation of the relevance of documents cited thereon, and English translations of the documents are not needed. The information disclosure statement was submitted with such an International Search report, and therefore, the documents should be considered, as required by MPEP 609 A(3) (see page 600-122, copy attached). These documents were cited in the counterpart PCT application, and therefore must be considered. Applicant respectfully requests notice that the documents have been properly considered.

Claims 7 and 10 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant believes the

claims as filed were clear, but claims 5 and 8 are amended herein with attention to the Examiner's concerns. Claims 7 and 10 are canceled, but concepts thereof have been incorporated into claims 5 and 8, respectively.

Claims 5-7 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Cockerill et al (U.S. 5,786,237). Applicant respectfully traverses. Claims 8-10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Cockerill et al (U.S. 5,786,237). Applicant respectfully traverses.

As noted above, claims 7 and 10 were canceled. Regarding claims 5 and 8, which are amended to incorporate concepts from claims 7 and 10, there is a distinct difference between applicant's claimed invention and the cited Cockerill et al document U.S. 5,786,237. While the Cockerill et al document does mention dividing into 1x4 or 1x3 or 1x2 or 1x1, it does not specifically state that it would make the division as a result of the testing as does applicant, making 4 element divisions if possible, but if not, making 2 element or 1 element divisions. The cited document, in contrast, appears to be pre-set for cutting a specific size pattern, either 1x4, 1x3, 1x2 or 1x1. Therefore, applicant's claimed invention is different, in that applicant, in accordance with the claims, is trying to maximize the number of higher yield components (4 piece components) but will make the smaller 2 or 1 piece components when that is the only size available. Thus, applicant's invention will not waste smaller 2 or 1 element pieces from the wafer. The cited document, in contrast, if set to cut 1x4 pieces, will make a

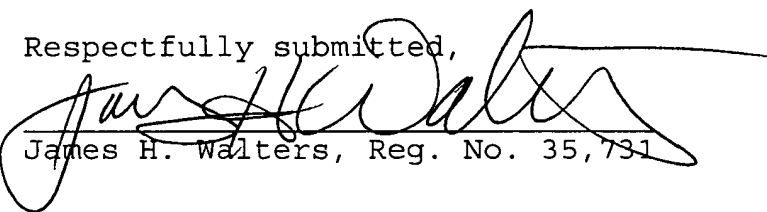
cutting pattern that will cut out only the preset 1x4 size pieces and if there are sections of the wafer that have 1x1 or 1x2 pieces only available, the cited document will leave those pieces wasted. Applicant's claimed invention will successfully employ those 1x1 or 1x2 pieces, leaving them unwasted.

In view of this, it is respectfully submitted that applicant's claims are allowable.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In light of the above noted amendments and remarks, this application is believed in condition for allowance and notice thereof is respectfully solicited. The Examiner is asked to contact applicant's attorney at 503-224-0115 if there are any questions.

Respectfully submitted,


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MARKUP VERSION TO SHOW CHANGES MADE

In the Claims:

5. (Amended) A method for manufacturing the semiconductor device, comprising:

a first step of forming a plurality of identical semiconductor chips on a semiconductor wafer;

a second step of carrying out a quality test for each of a plurality of said semiconductor chips formed on said semiconductor wafer; and

a third step of dividing one of a plurality of pieces of said semiconductor chips on the basis of a result of said quality test,

wherein said plurality of semiconductor chips are divided into first groups made of four pieces if four pieces are determined to be possible to form a group as a result of said step of carrying out a quality test, but wherein said chips are divided into second groups made of two pieces if four pieces are determined to be not possible to form a group as a result of said step of carrying out a quality test but if two pieces are determined to be possible, and wherein said chips are divided into third groups made of one piece if neither four pieces nor two pieces are determined to be possible to form a group as a result of said step of carrying out a quality test but if one piece is determined to be possible as a result of said quality test.

8. (Amended) A method for manufacturing the semiconductor device, comprising:

a first step of forming a plurality of identical semiconductor chips on a semiconductor wafer;

a second step of carrying out wiring, resin sealing, terminal formation for a plurality of said semiconductor chips formed on said semiconductor wafer;

a third step of carrying out a quality test of each of a plurality of said semiconductor chips, which is formed on said semiconductor wafer, by using said terminal formed by said second step; and

a fourth step of dividing one or a plurality of said semiconductor chips on the basis of a result of said quality test,

wherein said plurality of semiconductor chips are divided into first groups made of four pieces if four pieces are determined to be possible to form a group as a result of said step of carrying out a quality test, but wherein said chips are divided into second groups made of two pieces if four pieces are determined to be not possible to form a group as a result of said step of carrying out a quality test but if two pieces are determined to be possible, and wherein said chips are divided into third groups made of one piece if neither four pieces nor two pieces are determined to be possible to form a group as a result of said step of carrying out a quality test but if one piece is determined to be possible, after said quality test is carried out.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted)).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A (3) Concise Explanation of Relevance for Non-English Language Information

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in

37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

NOTE

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.